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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,623	07/07/2007	John Anthony Downes	102965-010100	1812

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GREENBERG TRAURIG LLP (LA)
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SANTA MONICA, CA 90404

EXAMINER

MEYER, JACOB B

ART UNIT	PAPER NUMBER
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3618

NOTIFICATION DATE	DELIVERY MODE
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10/14/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/599,623	Applicant(s) DOWNES, JOHN ANTHONY	
	Examiner JACOB MEYER	Art Unit 3618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-10 and 12-16 is/are pending in the application.
- 4a) Of the above claim(s) 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-10,12,14-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claim 13 remains withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. Also see previous two Office actions.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4, 6-10, 12, and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downes (UK Pat. No. 2,229,689), further in view of Metcalf (US Pat. No. 5,257,822), Jain et al (US Pat. No. 6,799,782), Morin (US Pat. No. 4,921,276), Bajorek et al (US Pat. No. 5,564,750), and Sheppard (US Pub. No. 2002/0109347).

Regarding claim 1, Downes discloses a device (Figure 1) for preventing spray from emerging from a wheel of a vehicle (Abstract), the device comprising a panel (the entire device disclosed in Figures 1-3, comprising 4-10) mounted behind a vehicle wheel and spaced therefrom (Figure 1) for receiving on a first side (location of 4 in Figure 1) water released by the wheel as it rotates (page 2, paragraphs 2-4), the panel including at least one passage (6) which leads from the first side to a rear second side of the panel (Figure 3), the at least one passage being other than normal to the plane of the panel (as seen from Figure 3), and at least one vertically extending water-collecting pocket (7) along the side of the at least one passage, wherein, in use, air and water entering the at least one passage are separated so that air passes

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through the at least one passage and mixes with ambient air on a second side of the panel, and water collects in the at least one water-collecting pocket (see at least paragraphs 2-3 of page 2). For further detail please see the remaining figures and specification. Downes discloses a panel (see above) that extends partially around a road wheel. Downes does not specifically disclose wherein said panel is planar and linearly and vertically extending and mounted vertically behind a vehicle wheel. Metcalf discloses a planar linearly and vertically extending panel mounted vertically behind a vehicle wheel (Figure 1, at 1) in use with a spray prevention device. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the technique of employing a planar linearly and vertically extending configuration mounted vertically behind a vehicle wheel, as in Metcalf, with the structure as disclosed in Downes, since it was well-known in the art to provide spray guards that are planar and mounted vertically behind a vehicle wheel, since this arrangement would provide an easily interchangeable or replaceable spray prevention device for on-road vehicles providing greater spray suppression. Therefore, the above combination is no more than the simple application of a known technique to a piece of prior art ready for improvement yielding the predictable results of an easily interchangeable or replaceable spray prevention device for on-road vehicles providing greater spray suppression. Please note that it is merely the techniques being disclosed by the prior art that are of importance to the combination, and as a result, it would have also been obvious to one having ordinary skill in the art to alternatively substitute the technique of Downes with the teachings of Metcalf. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have applied the known technique of the spray suppression technique as disclosed by the structure of Downes to a piece of prior art ready

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for improvement as with the planar linearly and vertically extending guard mounted vertically behind a vehicle wheel as in Metcalf, thus yielding the predictable results of an easily interchangeable or replaceable spray prevention device for on-road vehicles providing greater spray suppression. Additionally, Jain discloses a device for preventing spray from emerging from a wheel of a vehicle mounted vertically behind a vehicle wheel and spaced therefrom (at least Figure 1). Further examples such as Morin '276, Bajorek '750, and Sheppard '347 similarly disclose configurations of vehicle spray prevention systems comprising panels mounted vertically behind a vehicle wheel and spaced therefrom (see Figures), wherein at least Sheppard, Bajorek, and Morin disclose planar linearly and vertically extending panels (see Figures). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the spray prevention configuration of Downes (regarding the vanes, passages, and channels) into any one of these mounting configurations and locations as additionally provided in Jain, Morin, Bajorek, and Sheppard, since it was well-known in the art to provide spray prevention devices comprising panels mounted vertically behind a vehicle wheel and spaced therefrom, and wherein said panels are planar linearly and vertically extending; and since each of these configurations provides greater applicability of the device so as to be more easily interchangeable or replaceable (by the various mounting techniques disclosed).

Regarding claim 2, Downes in view of the combination above discloses the invention wherein the panel is formed from a plurality of vertically extending baffles (at least shown at 4, 5 of Figure 3 of Downes) positioned in a side by side relationship with passages therebetween (also see page 2, paragraph 4 of Downes).

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Regarding claim 3, Downes in view of the combination above discloses the invention wherein the plurality of vertically extending baffles are substantially identical in shape (Figure 3, and page 2 at least at paragraph 4 of Downes).

Regarding claim 4, Downes in view of the combination above discloses the invention wherein the plurality of vertically extending baffles overlap one another (at least at Figure 3, and page 2 paragraph 4 of Downes).

Regarding claim 6, Downes in view of the combination above discloses the invention wherein the at least one passage is non-linear (at least at Figure 3, and page 2 paragraph 4 of Downes).

Regarding claim 7, Downes in view of the combination above discloses the invention wherein the water-collecting pockets are arranged so as to collect water following a change of direction in the at least one passage (at least at Figure 3, and page 2 paragraph 4 of Downes). It is noted that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

Regarding claim 8, Downes in view of the combination above discloses the invention wherein the at least one passage has two changes of direction (at least at Figure 3, and page 2 paragraph 4 of Downes).

Regarding claim 9, Downes in view of the combination above discloses the invention wherein the at least one pocket is a channel running substantially vertically along a respective baffle, so that, in use, water drains from the baffles onto a surface on which the wheel is traveling (at least at Figure 3, and page 2 paragraph 4 of Downes).

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Regarding claim 10, Downes in view of the combination above discloses the invention wherein the channel is substantially U-shaped (at least at Figure 3, and page 2 paragraph 4 of Downes).

Regarding claim 12, Downes in view of the combination above discloses the invention wherein the baffles overlap one another (at least at Figure 3, and page 2 paragraph 4 of Downes).

Regarding claim 14, Downes in view of the combination above discloses a method for preventing spray from emerging from a wheel of a vehicle, the method comprising: providing a linear and vertically extending planar panel for receiving on a first side water released by the wheel as it rotates, the panel including at least one vertically extending passage which leads from the first side to a rear second side of the panel, the at least one passage being other than normal to the plane of the panel, and at least one water-collecting pocket along a side of the at least one passage, wherein, in use, air and water entering the at least one passage are separated so that air passes through the at least one passage and mixes with ambient air on a second side of the panel, and water collects in the at least one water-collecting pocket; and mounting the planar panel substantially vertically behind a vehicle wheel and spaced therefrom for the reasons stating obvious with respect to claim 1 above. The apparatus as claimed is obvious over Downes in view of the combination as discussed above regarding claim 1. Furthermore, since the prior art device as disclosed with reference to the independent claim in its normal and usual operation would be utilized in the manner as claimed herein as a method for preventing spray from emerging from a wheel of a vehicle, the claimed method is considered to be obvious in view of the prior art device. It has been held that when the prior art device is the same as a device described in the specification for carrying out the claimed method, it can be assumed the device

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will inherently perform the claimed process. Additionally, it has been held that to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not amount to the mere claiming of a use of a particular structure.

Regarding claim 15, Downes in view of the combination discussed with reference to claim 1 above discloses a device for preventing spray from emerging from a wheel of a vehicle, said vehicle having a wheel arch extending over said wheel, the device comprising a planar linearly and vertically extending panel vertically behind and spaced from a vehicle wheel and below said wheel arch for receiving on a first side water released by the wheel as it rotates, the panel including at least one passage which leads from the first side to a rear second side of the panel, the at least one passage being other than normal to the plane of the panel, and at least one vertically extending water-collecting pocket along a side of the at least one passage, wherein, in use, air and water entering the at least one passage are separated so that air passes through the at least one passage and mixes with ambient air on a second side of the panel, and water collects in the at least one water-collecting pocket (see claim 1 above). At least Sheppard, Morin, and Jain disclose spray prevention devices below said wheel arch for receiving water released by the wheel (see Figures of Sheppard, Morin, and Jain). As noted above regarding claim 1, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the spray prevention configuration of Downes (regarding the vanes, passages, and channels) into any one of the above mounting configurations and locations as provided in Metcalf, Jain, Morin, Bajorek, and Sheppard. Additionally, it would have been obvious to mount said devices particularly below said wheel arch for receiving water released by the wheel, since it was well-known in the art to provide spray prevention devices below said wheel arch for

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receiving water released by the wheel (as in Sheppard, Morin, and Jain), and since mounting below said wheel arch provides optimal spray suppression and wheel well aeration in addition to providing ease of interchangeability or replacement of said device (see disclosure of Sheppard, Bajorek, Morin, Jain, and Metcalf). It has been held that when there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product is not of innovation but of ordinary skill and common sense.

Regarding claim 16, Downes in view of the combination discussed above regarding claims 1 and 15 discloses a method for preventing spray from emerging from a wheel of a vehicle, said vehicle having a wheel arch extending over said wheel, the method comprising: providing a linear and vertically extending planar panel for receiving on a first side water released by the wheel as it rotates, the panel including at least one vertically extending passage which leads from the first side to a rear second side of the panel, the at least one passage being other than normal to the plane of the panel, and at least one water-collecting pocket along a side of the at least one passage, wherein, in use, air and water entering the at least one passage are separated so that air passes through the at least one passage and mixes with ambient air on a second side of the panel, and water collects in the at least one water-collecting pocket; and mounting the planar panel vertically behind and spaced from a vehicle wheel and below said wheel arch. As noted above regarding claim 14, the apparatus as claimed is obvious over Downes in view of the combination as discussed above regarding claims 1 and 15. Furthermore, since the prior art device as disclosed with reference to the independent claim in its normal and

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usual operation would be utilized in the manner as claimed herein as a method for preventing spray from emerging from a wheel of a vehicle, the claimed method is considered to be obvious in view of the prior art device. It has been held that when the prior art device is the same as a device described in the specification for carrying out the claimed method, it can be assumed the device will inherently perform the claimed process. Additionally, it has been held that to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not amount to the mere claiming of a use of a particular structure.

Response to Arguments

3. Applicant's arguments with respect to all previously pending claims have been considered but are moot in view of the new ground(s) of rejection. Additionally, Applicant's arguments filed 07/28/2010 have been fully considered but they are not persuasive. Applicant argues that the device of the instant application can be adapted to a pre-existing vehicle by mounting whereas Downes, which is argued to replace a standard OEM wheel arch, where OEM manufacturers do not easily adapt products of others outside the company. The device of both Downes and the instant application are no different in the sense that both would have to be adapted to fit the varying specifications of different manufacturers. Moreover, it is noted that the features upon which applicant relies (i.e., the adaptability of Applicant's claimed apparatus) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. Also, with reference to Applicant's arguments in paragraph 2 of page 7 of the response, it is noted that the features upon which applicant relies (i.e., the device mounted below the wheel arch located in a standard wheel arch

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environment) are not recited in the rejected claim(s) Applicant is referring to (claims 1 and 14). Again, it is noted that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. As noted above regarding the applied prior art, numerous locations have been utilized previously for mounting spray prevention devices. Incorporating the device structure (regarding vanes, channels, and passages) as disclosed in Downes with a well-known location such as planar linearly and vertically extending vertically behind and spaced from a vehicle wheel and below said wheel arch, as disclosed in the other of the above noted references, would have been no more than the simple application of a known technique to a piece of prior art ready for improvement yielding the predictable results as discussed above.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to JACOB MEYER whose telephone number is (571)270-3535.

The examiner can normally be reached on Monday - Thursday 9am to 7pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. ALLEN SHRIVER can be reached on 571-272-6698. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. ALLEN SHRIVER II/
Supervisory Patent Examiner, Art Unit 3618

/J. M./
Examiner, Art Unit 3618